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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/570,913

03/01/2006

Dong-Ming Shen

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7590

02/08/2008

MERCK AND CO., INC

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

02/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/570,913

Applicant(s)

SHEN ET AL.

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 12-15 is/are rejected.
- 7) ☐ Claim(s) 1-11 and 16-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date 2. | 6) <input type="checkbox"/> Other: _____ |

Claims 1-19 are pending in this application.

Response to Restriction

The election of group I, with traverse in the Paper filed 12/10/07 is hereby acknowledged. The traversal is on the basis that a reasonable number of species may be claimed if there is allowable generic claim, and that the inventions are amides substituted by alkyls. This is not persuasive because applicant fails to identify the allowable generic claim. Applicant further contends the inventions were not subject to lack of unity of invention during International Examination, and that no National law should apply. This is not persuasive because the inventions lacks unity of invention under PCT Rules 13.1 and 13.2 as set forth in the Restriction Requirement. Also, the International Examination was performed on only claims 11, 16-17, for reasons set forth in the ISR. Applicant requests rejoinder of group II. Group II has been rejoined. Having found the examples of group I and II in condition for allowance, the invention of group VII, method of use, is now rejoined as well and is examined commensurate in scope with the examples in groups I and II.

The other restriction is still deemed proper and therefore made FINAL.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12-15 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Under US patent practice, a use claim without setting forth the steps involved in the process is an improper definition of a process, under 35 U.S.C. See *Ex parte Dunki*, 153

USPQ 678 (Bd. App, 1967) and *Clin. Products v. Brenner*, 149 USPQ 475 (D.D.C., 1966). By deleting the claim the rejection would be overcome.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-15, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims lack adequate support in the specification. There is no evidence in the specification that the inventive compounds would treat glaucoma, diabetes, Alzheimer, depression, and all the other diseases listed in the claims. Glaucoma is an irreversible damage. While the compounds may reduce optic pressure, once the damage is done reducing the pressure cannot reverse the damage. The listed diseases are secondary to diabetic condition and treatment of a secondary disease is not the same as treating the primary disease or treatment of all secondary diseases arising from the same primary cause. There is no conclusive evidence in the specification that contradicts these well known facts. The assays on pages 43-45 of the specification support reducing optic pressure and by limiting the claims to this utility the rejection would be overcome.

Objection

Claims 1-19 are objected to for containing non-elected invention. Applicant must amend the compounds within the scope of examples in groups I-II.

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Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Solola', with a stylized flourish extending to the left.

**TAOFIQ SOLOLA
PRIMARY EXAMINER**

Group 1625

January 29, 2008